

REMARKS

This is in response to the Office Action dated February 23, 2011. In view of the foregoing amendments and following representations, reconsideration is respectfully requested.

1. Claim Amendments under 37 CFR 1.173

On page 3 of the Office Action, the Examiner states that the claims do not comply with 37 CFR 1.173. In response, a corrected claims section is submitted herewith. As per Rule 173(d) deletions in the patent claims are enclosed in brackets and additions are underlined. Accordingly, the amendments to the claims are now in compliance with 35 CFR 1.173.

2. Written Consent of Assignee

On page 2 of the Office Action, the application is objected to under 37 CFR 1.172(a) as lacking the written consent of all assignees owning an undivided interest in the patent. The Examiner asserts that there is no record of assignment for this patent and that the reel/frame numbers given are for U.S. Patent No. 5,967,445. However, the present reissue application is based on a divisional of the application that issued as U.S. Patent No. 5,967,445. As per MPEP 306:

In the case of a division or continuation application, a prior assignment recorded against the original application is applied >(effective)< to the division or continuation application because the assignment recorded against the original application gives the assignee rights to the subject matter common to both applications. >Although the assignment recorded against an original application is applied to the division or continuation application, the Office's assignment records will only reflect an assignment of a division or continuation application (or any other application) if a request for recordation in compliance with 37 CFR 3.28, accompanied by the required fee (37 CFR 3.41), is filed.<

Thus, the assignment in the parent application is effective as the assignment in the divisional application, i.e. the application which issued as U.S. Patent No. 6,268,780.

3. Supplemental Declaration

On page 3 of the Office Action, the Examiner indicates that a supplemental declaration will need to be filed as per MPEP 1414. Accordingly, upon receiving an indication that all issues have been resolved, Applicant will file a supplemental declaration stating that all errors arose without deceptive intention on the part of the Applicant.

4. Claim Rejection - 35 U.S.C. 251

On page 2 of the Office Action, claims 1-3 are rejected under 35 U.S.C. 251 as being improperly broadened. Applicant has subsequently been informed by the Examiner that the rejection of claims 1-3 is based on the contention that reissue claims 1-3 impermissibly recapture subject matter surrendered during the prosecution in parent application no. 09/533,436 (now patent no. 6,286,780). In the rejection, the Examiner explains that:

“In the instant case, the applicant amended claim 1 of the original patent to recite “a cylindrical second rotary shaft having a cylindrical outer periphery and a cylindrical inner periphery, sheet material wound on said cylindrical outer periphery of said second rotary shaft”. In the remarks filed by the applicant on May 8, 2001, the applicant presented arguments as to the patentability of the claim by stating that the Satoh reference could not anticipate the claims because these limitations were not present in the Satoh reference. Thus, these limitations must be retained in any reissue claims.”

Although the indicated limitations were deleted from the last paragraph of patent claim 1, these limitations were inserted in the first paragraph of reissue claim 1. In particular, the first paragraph of claim 1 recites that the assembly comprise a cylindrical core pipe having a cylindrical outer periphery and a cylindrical inner periphery, and a roll of sheet material wound around said cylindrical outer periphery of said core pipe. Thus, the limitations identified by the Examiner are actually present in the first paragraph of claim 1.

Further, the actual statement made during the prosecution was “since the rotary member of Satoh does not have a cylindrical inner periphery, it clearly does not meet each and every limitation of claim 8, and thus cannot anticipate this claim under 35 U.S.C. 102(b).” Reissue claim 1 clearly recites that the cylindrical core pipe has a cylindrical outer periphery and a cylindrical inner periphery.

In view of the above, it submitted that the broader aspects of the reissue claims do not relate to surrendered subject matter, and therefore the reissue claims do not violate the rule against recapture.

Claims 4-9 are allowed. Accordingly, the present application is now clearly in condition for allowance. The Examiner therefore is requested to pass this case to issue.

In the event that the Examiner has any comments or suggestions of a nature necessary to place this case in condition for allowance, then the Examiner is requested to contact Applicant's undersigned attorney by telephone to promptly resolve any remaining matters.

Respectfully submitted,

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/Michael S. Huppert/

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